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Davidson, Davidson & Kappel, LLC			EXAMINER	
485 7th Avenue			PETERSON, KENNETH E	
14th Floor				
New York, NY 10018				
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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* MICHAEL LEE HEARN

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Appeal 2008-002791  
Application 09/533,685  
Technology Center 3700

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Decided: March 31, 2010

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Before: LINDA E. HORNER, WILLIAM F. PATE III, and  
JOHN C. KERINS, *Administrative Patent Judges*.

PATE III, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE

Appellant appeals under 35 U.S.C. § 134 from a rejection of claims 22-30, 33-38, and 40.<sup>1</sup> We have jurisdiction under 35 U.S.C. § 6(b).

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<sup>1</sup> Similar claims in this application have been before the Board before in Appeal No. 2005-2097. The decision was rendered on January 18, 2006.

The claims are directed to a cutting and nipping device for accurately cutting signatures in a bookmaking process. Claim 22, reproduced below, is illustrative of the claimed subject matter:

22. A cutting and nipping device for cutting and nipping a web, comprising:

a first cutting cylinder having a first segmented cutting blade with axially spaced first blade edges and having first blade sides and a first cutting cylinder nipping surface extending circumferentially about the first cutting cylinder from the first blade sides; and

a first anvil cylinder having a first anvil cylinder nipping surface extending circumferentially about the first anvil cylinder;

the first cutting cylinder nipping surface and the first anvil cylinder nipping surface providing a first nip for the web about the first segmented cutting blade,

the first blade edges extending radially beyond the first cutting cylinder nipping surface when the first blade edges are apart from the first anvil cylinder.

## REFERENCES

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Brown '410	US 2,951,410	Sep. 6, 1960
Henc	US 3,119,312	Jan. 28, 1964
Sauer	US 3,522,762	Aug. 4, 1970
Wolfberg	US 3,866,497	Feb. 18, 1975
Marcus	US 3,921,481	Nov. 25, 1975
Jespersen	US 4,142,431	Mar. 6, 1979
Brown '914	US 5,359,914	Nov. 1, 1994
Irsik	US 5,967,512	Oct. 19, 1999

Bussey, III	US 6,418,827 B1	Jul. 16, 2002
Kirkpatrick, Jr.	US 6,435,069 B1	Aug. 20, 2002

### REJECTIONS

Claims 22, 26 and 33 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Bussey. Ans. 3.

Claims 22, 26, 28, 30, 33 and 36 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Wolfberg. Ans. 4.

Claims 22, 26, 28 and 33 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Brown '410 and Jespersen. Ans. 5.

Claims 22, 26, 28, 30, 33 and 36 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Marcus in view of Wolfberg. Ans. 6.

Claim 26 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Bussey and Henc or Sauer. Ans. 7.

Claims 26 and 28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Wolfberg and Henc or Sauer. Ans. 8.

Claims 26 and 28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Marcus, Wolfberg and Henc or Sauer. Ans. 8.

Claims 26 and 28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Brown '410, Jespersen, and Henc or Sauer. Ans. 9.

Claims 23, 27, 29, 34, 37 and 40 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Marcus, Wolfberg, Henc or Sauer and Brown '914. Ans. 9.

Claims 24, 25, 35, and 38 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Marcus, Wolfberg, Henc or Sauer and Kirkpatrick. Ans. 10.

Claims 23, 24, 27, 29, 34, 35 and 40 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Brown '410, Jespersen, Henc or Sauer, and Irsik. Ans. 10.

### ANALYSIS

We have carefully reviewed the rejections on appeal in light of the arguments of the Appellant and the Examiner. As a result of this review, we have reached the determination that the applied prior art does not establish the lack of novelty or the prima facie obviousness of the claims on appeal. Accordingly, all rejections on appeal are reversed. Our reasons follow.

In the prior appeal, the panel construed the claim term “nip” in a web printing press as being the location where the web is squeezed or compressed together so that the web in the nip does not slip or move with respect to the cylinder in a way that could affect print-to-print or print-to-cut registration. See prior decision at 5. We adopt this claim construction as our own, and will construe the claims and the prior art based on this definition.

Turning to the rejection under § 102 based on the Bussey reference, Bussey discloses a perforating machine for perforating plastic foam web and plastic bubble web. See col. 2, ll. 11-16. During the perforating operation, the web to be perforated is supported by brush roll 45. See col. 5, ll. 20-22. Bussey states, “[t]he brush roll 45 may be formed of a plurality of upstanding filaments so as to provide a suitable surface for gently supporting the traveling web 15 and for rotating therewith.” See col. 5, ll. 43-46. This sentence is dispositive of this rejection. Bussey clearly states that the web is merely gently supported by the brush roll 45, and this gentle support is inimical to the Appellant’s claimed nip. Accordingly, claims 22, 26, and 33 do not lack novelty over the Bussey reference.

Turning to the rejection of claims 22, 26, 28, 30, 33, and 36 as anticipated by Wolfberg, we will not sustain this rejection. We acknowledge the Examiner's argument that Wolfberg would be capable of engaging the web of business forms in a nip during perforating, especially if the web were thicker. This rejection is based on the principle of inherency, and the Examiner must show that the disclosure of Wolfberg necessarily provides the claimed nip. The Examiner has not sustained this burden. We are in agreement with the panel that reviewed a rejection in the previous appeal based on the Wolfberg reference and determined that the Examiner's rejection was based on speculation and conjecture. The Examiner can point to no disclosure in Wolfberg that the claimed nip is formed. In fact, it is possible that if the claimed nip were formed in the device of Wolfberg, the compression of the web would result in carbon paper transfer on the underlying sheets. Therefore, the Examiner has not established that claims 22, 26, 28, 30, 33, and 36 lack novelty over the Wolfberg disclosure.

Turning to the rejection of claims 22, 26, 28, and 33 under § 103 as unpatentable over Brown '410 in view of Jespersen, we will not sustain this rejection. Brown is directed to an apparatus for cutting chaff. The chaff is cut on an angle and thereafter dispersed. See col. 1, ll. 15-19 and col. 4, ll. 73-75. Brown differs from the claimed subject matter in that the claimed subject matter requires a segmented blade. Jespersen discloses a paper towel dispenser with a segmented blade that perforates the paper towel material before it is dispensed so that the user may sever the web. See col. 4, ll. 24-43. We are in agreement with the Appellant that there is no articulated reasoning with a rational underpinning for the combination of these two

references. It is unclear why one of ordinary skill would use a segmented blade in the chaff dispenser of Brown. The Examiner's rejection appears to posit a situation in which a user would manually separate the pieces of chaff after perforation. We regard this as a far-fetched scenario. Accordingly, we will not sustain this obviousness rejection.

Next considering the rejection of claims 22, 26, 28, 30, 33, and 36 as unpatentable over Marcus in view of Wolfberg under § 103, we will not sustain this rejection. Marcus is directed to a cutter for cutting a web of newspaper. Marcus discloses a knife 34 surrounded by elastomeric cheeks 40 and 46. See col. 3, ll. 10-16; 17-45. A receptacle 12a is provided for receiving the knife blade 12. See col. 3, ll. 46-48. These elastomeric members are designed so that the paper or web compresses the first and second cheeks. See col. 2, ll. 27-29. However, Marcus does not disclose a first cutting cylinder nipping surface extending circumferentially about the first cutting cylinder from the blade sides. If any nipping is occurring in Marcus it is directly at the cutting surface, and there is no nipping extending out circumferentially from the blade. Since we have already determined that Wolfberg does not disclose the claimed nipping, neither Wolfberg nor Marcus discloses this claimed feature. Therefore, the rejection of these claims under § 103 cannot be sustained.

Concerning the rejection of claim 26 as unpatentable over Bussey in view of Henc or Sauer, neither Henc nor Sauer ameliorates the difficulties we have found with the base reference Bussey. Therefore the rejection of claim 26 under § 103 as unpatentable over Bussey in view of Henc or Sauer is reversed.

Regarding the rejection of claims 26 and 28 as unpatentable over Wolfberg in view of Henc or Sauer or as unpatentable over Marcus, Wolfberg, Henc and Sauer, as we have seen, neither Wolfberg nor Marcus discloses the claimed nipping and Henc and Sauer are not cited for this claimed feature. Thus, the rejections of these claims are not sustained.

Concerning the rejection of claims 26 and 28 as being unpatentable over Brown '410, Jespersen, and Henc or Sauer, Henc and Sauer add nothing that we have found to be lacking in the combined teachings of Brown and Jespersen. Accordingly this rejection is reversed.

Similarly the rejection of claims 23, 27, 29, 34, 37, and 40 as unpatentable over Marcus, Wolfberg, Henc or Sauer, and Brown '914 is not sustained. This rejection is reversed, inasmuch as neither Marcus nor Wolfberg discloses the claimed nipping relationship and Henc, Sauer and Brown also do not provide this feature.

Lastly, the rejection of claim 24, 25, 35, and 38 as unpatentable over Marcus, Wolfberg, Henc or Sauer and Kirkpatrick and the rejection of claims 23, 24, 27, 29, 34, 35, and 40 as unpatentable over Brown '410, Jespersen, Henc, Sauer and Irsik are not sustained for the same reasons.

#### DECISION

For the above reasons, the Examiner's rejections of all of the claims on appeal are reversed.

#### REVERSED

Vsh



Appeal 2008-002791  
Application 09/533,685

DAVIDSON, DAVIDSON & KAPPEL, LLC  
485 7TH AVENUE  
14TH FLOOR  
NEW YORK NY 10018